

REMARKS

In accordance with the foregoing, the specification and claims 1, 2, 4, 6, 8 and 13 have been amended. No new matter is being presented, and approval of the amendments and reconsideration of the claims are respectfully requested.

Amendments to the Specification

The term “telephone numbers” on page 12 of the English language description is a mistranslation of the original Japanese term. The term “telephone numbers” should be replaced with “an address book” to conform to the original Japanese disclosure. Specifically, the Japanese term included in the Japanese description and claims originally filed as a PCT application is “電話帳”, which in English translates to something that stores telephone numbers in one-to-one correspondence with user names, for example, such as a list and/or a database.

Applicant submits that “電話帳” is equivalent to “an address book”, when translated into English. Therefore, page 12 of the present specification is amended herein to clarify this informality. Approval of the amended specification is respectfully requested.

Rejection under 35 U.S.C. §112

On page 2 of the Action, claim 1 is rejected under 35 U.S.C. §112, first paragraph, as being indefinite. Specifically, the Examiner states that the phrase “operable to” is indefinite, since it is unclear as to whether the limitations following the phrase are part of the claimed invention.

The claims have been amended herein to remove the phrase “operable to.” Accordingly, it is respectfully submitted that the claims particularly point out and distinctly claim the subject matter of the invention. Reconsideration and withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. §102(b)

Claim 1 stands rejected as being anticipated by Satoh (EP 0881 587). The rejection is respectfully traversed and reconsideration is requested. The following is a comparison between embodiments of the present invention and the cited reference.

Embodiments of the present invention, as recited in amended claim 1, are characterized in that the terminal device comprises: "a creating unit to, if the specific command is interpreted as an instruction to create a list of one or more targets, which are specified by the specific command, create, from the targets stored in memory of the terminal device, the list of the one or more targets which are specified by the specific command; and a mail transmitting unit to create and transmit a mail having the created list as a mail main body and addressed to a requestor."

According to these features of amended independent claim 1, embodiments of the present invention can include list information, which one of ordinary skill in the art would realize has a small data size, and is created from information relating to targets, which one of ordinary skill in the art would realize has a large data size. Based on the list thus created, information relating to specific targets can be obtained.

For support, in the original description and drawings the following exemplary cases are disclosed with respect to the specific command. In FIG. 6, the specific command is an instruction to "create a list by selecting the thirty most recently received incoming mails from mails in the incoming mailbox and send the list." In FIG. 7, the specific command is an instruction to "make a list by selecting schedules of the thirty latest upcoming events from a schedule box and send the list." In FIG. 8, the specific command is an instruction to "make a list by selecting the thirty latest images from an image box and send the list."

In view of these exemplary cases, the specific command can be deemed as an instruction to "send, from among the targets, a predetermined number of specific targets." Furthermore, the amended description states, on page 12, "[i]n the above-preferred embodiment, incoming mails, schedules, and images are used as examples of the target, however, the present invention is not

limited to these. Transmitted mails, an address book, received voice calls, transmitted voice calls, positional information, or the like can also be the target of the present invention.”

These statements suggest that there could be different variations of the present invention. For example, in a case where an address book is the target, the sender of the mail (requestor) can create a specific command that instructs the terminal device to send all of the names of registered individuals which start with 'A', in one-to-one correspondence with their telephone numbers, instead of sending a predetermined number of contact information pieces. Embodiments of the present invention are unique in that a specific command is an instruction to create a list of one or more targets which are specified by the specific command, and based on this instruction, the “list of the one or more targets which are specified by the specific command is created from the targets stored in memory of the terminal device,” and the created list can be transmitted to the requestor in the form of a mail.

On the other hand, Satoh discloses that when a user transmits, from its terminal (hereinafter, "user terminal"), an E-mail containing a mail keyword to another remote terminal (proxy server) that holds E-mails to be addressed to the user terminal, the proxy server (i) automatically generates a file containing one of the E-mails to be addressed to the user terminal, which is indicated by the mail keyword, and (ii) transmits, to the user terminal (requestor), the generated file in the form of an E-mail.

According to Satoh, the proxy server also includes, into the file, the received E-mail containing the mail keyword, and transmits the file to the requestor. Unlike embodiments of the present invention, the structures disclosed in Satoh allow neither (i) creating list information, which has a small data size, from information relating to targets, which has a large data size, nor (ii) obtaining information relating to specific targets based on the list thus created.

In other words, Satoh neither teaches nor suggests any technology that corresponds to the creating unit and the mail transmitting unit as recited in amended independent claim 1. Therefore, it is respectfully submitted that independent claim 1 patentably distinguishes over Satoh.

Rejections under 35 U.S.C. §103(a)

Claims 1-7 and 9-13 stand rejected as being unpatentable over L'Heureux (U.S. Patent No. 6,697,942) in view of Satoh (EP 0881 587). The rejections are respectfully traversed and reconsideration is requested. The following is a comparison between embodiments of the present invention and the cited art.

As described above, embodiments of the present invention, as recited in independent claim 1, are characterized in that the terminal device comprises the aforementioned creating unit and mail transmitting unit.

As described above, Satoh neither teaches nor suggests any technology that corresponds to the creating unit and the mail transmitting unit recited in independent claim 1. Unlike embodiments of the present invention, the technology disclosed in Satoh allows neither (i) creating list information, which has a small data size, from information relating to targets, which has a large data size, nor (ii) obtaining information relating to specific targets based on the list thus created.

According to L'Heureux, a remote terminal receives, from an external device, an email in which a command has been embedded, and generates, for example, an address list by executing the command. L'Heureux also discloses technology for notifying the transmitter of the result of executing the command.

L'Heureux relates to a conventional system of adding new addresses to an existing address list and deleting unnecessary addresses from the existing address list. The technology disclosed in L'Heureux does not allow creating list information, which has a small data size, from information relating to targets, which has a large data size.

Furthermore, the technology disclosed in L'Heureux merely notifies the transmitter of *the result of executing the command*, but does not notify the transmitter of the created address list.

In other words, the technology disclosed in L'Heureux allows neither (i) creating list information, which has a small data size, from information relating to targets, which has a large data size, nor (ii) obtaining information relating to specific targets based on the list thus created.

On the other hand, the terminal device recited in amended independent claim 1 comprises the aforementioned creating unit and mail transmitting unit, and therefore, as exemplary advantages, allows (i) creating list information, which has a small data size, from information relating to targets, which has a large data size, and (ii) obtaining information relating to specific targets based on the list thus created.

Therefore, it is respectfully submitted that independent claim 1 patentably distinguishes over L'Heureux and Satoh, alone or in combination. Dependent claims 2-7 and 9-13 inherit the patentability of independent claim 1, and are thus submitted to be patentable for at least the foregoing reasons.

Rejections under 35 U.S.C. §103(a)

Claim 8 stands rejected as being unpatentable over L'Heureux (U.S. Patent No. 6,697,942) in view of Satoh (EP 0881 587) and further in view of Day (U.S. 2003/0224760). Claim 8 depends from independent claim 1, which patentably distinguishes over L'Heureux and Satoh for the reasons presented herein.

It is further submitted that Day fails to cure the deficiencies of the cited art, and is not cited as such. The Examiner merely indicates that paragraphs [0037] to [0039] of Day disclose that if the targets are received mails, a list including a sender, a received date and a subject is displayed. Therefore, claim 8 is submitted to be in condition for allowance for at least the foregoing reasons.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 278542014100. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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